

## **REMARKS**

### **INTRODUCTION:**

In accordance with the foregoing, claims 45 and 52 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-52 are pending and under consideration. Reconsideration is respectfully requested.

### **ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicants' request(s) entry of this Rule 116 Response and Request for Reconsideration because: the amendment of claims(s) 45 and 52 address objections to claims 45 and 52 and an indefiniteness of claim 45 and do not change the substantive scope of the claims; it is believed that the amendment of claims(s) 45 and 52 puts this application into condition for allowance as suggested by the Examiner; the amendment(s) of claim(s) 45 and 52 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; the amendment(s) do not significantly alter the scope of the claims and place the application at least into a better form for appeal and no new features or new issues are being raised; and/or the reference(s) applied to the claims are newly cited in the final Office Action, and Applicant(s) should be provided the opportunity to present patentability arguments and amendments in view thereof.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

#### **I. CLAIM OBJECTIONS**

In the Office Action, at page 2, numbered paragraph 4, claims 45 and 52 were objected to for having grammatical informalities.

In accordance with the foregoing, claims 45 and 52 have been amended taking into consideration the Examiner's comments. Accordingly, withdrawal of the objection to claims 45 and 52 is respectfully requested.

II. REJECTION UNDER 35 U.S.C. §112:

In the Office Action, at pages 2-3, numbered paragraph(s), 5-6, claim 45 was rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

In accordance with the foregoing, claim 45 has been amended taking into consideration the Examiner's comments. Accordingly, withdrawal of the rejection to claim 45 is respectfully requested.

III. REJECTION UNDER 35 U.S.C. §101:

In the Office Action, at page 3, numbered paragraph(s), 7-8, claims 50-52 were rejected under 35 U.S.C. §101 for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

If a claim recites a useful, concrete, and tangible result, the claim is limited to a practical application, and is therefore statutory. See MPEP at §2106(IV)(B)(2)(b)(ii) (Statutory Process Claims - Safe Harbors); State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Withdrawal of the 35 USC 101 rejection is respectfully requested, because independent claims 50, 51, and 52 positively recite concrete, useful and tangible elements such as a visibly tangible tracking symbol for use by a user as well as a menu which is also visibly concrete and therefore tangible. Both the tracking symbol and menu are tangible and utilized by human interface devices such as an input transducer like a mouse or stylus which is recited in claims 50-52.

In addition, a graphical user interface is defined as

An interface for issuing commands to a computer utilizing a pointing device, such as a mouse, that manipulates and activates graphical images on a monitor.

(See The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2006 by Houghton Mifflin Company)

Because a graphical user interface like that of claims 50-52 is utilized by definition with devices such as a mouse, keyboard, or even a stylus, claims 50-52 are not software per se, but a conduit through which to issue commands to a computer and as a result, data and memory stored within the computer.

Further, the Examiner rejects these claims because "no physical and tangible computer structure" is being recited. The Examiner is requested to further note claims 50-52 recite controls and a control is defined as:

Control - In a graphical user interface, an object on the screen that can be manipulated by the user to perform an action.  
(See Microsoft Computer Dictionary ©1999)

As defined by Microsoft, a control is an object that can be manipulated and, thus, is a physical and tangible computer structure

Therefore, claim 50-52 are within the technological arts, and withdrawal of the 35 USC 101 rejection of claims 50-52 is respectfully requested.

It is noted that claim 49, also

#### IV. REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at pages 3-6, numbered paragraph(s), 9-10, claims 32-33 and 50-52 were rejected under 35 U.S.C. §102 in view of Strauss, Patent No. US 6,246,411 B1. This rejection is traversed and reconsideration is requested.

The rejection of claim 32 is respectfully traversed because the menu of the present Application is not disclosed either expressly or inherently by the Drag Toolbar of Strauss. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As noted in col. 8, lines 16-17, the Drag Toolbar is only available after a drag operation is initiated. Therefore, the Drag Toolbar fails to allow the user to be cognizant of options available via the Toolbar to the user when a drag has not been initiated. The menu of the present invention is not dependent upon another operation such as a drag operation. Dependence upon a drag operation adds extra steps to the eventual display of the menu, requiring extra time and effort which is specifically avoided in this Application. In other words,

Strauss fails to disclose or describe, either expressly or inherently, as required by *Verdegaal Bros. v. Union Oil*, the claimed:

allowing a user to move a tracking symbol on a display; and  
moving a tracking menu in correspondence to the symbol **when  
the symbol encounters an edge of the menu.**

Furthermore, the rejection of claim 32 is respectfully traversed because Strauss does not disclose, either expressly or inherently, a method which allows a user to move a tracking symbol on a display such that when the symbol encounters an edge of the **menu**, the menu moves in correspondence with the symbol. The Office Action's interpretation of the "zone boundary as the edge of the menu" on page 27 is respectfully traversed. It is contrary to the discussion and disclosure in Strauss at col. 6, lines 59-67 and fig. 7 to assume that the "follow me" zone boundary, 42 is to be interpreted as the edge of the menu as in the present Application as they markedly differ in fig. 7. Furthermore, by making both the menu boundary and drag boundary (or follow me zone boundary) coincident, as is done in the present Application, this causes both selection and dragging of an object, which is taught away from in Strauss. Strauss also fails to disclose exactly what happens when the toolbar is moved except the disclosure in col. 3, lines 54-59 which underscores that the toolbar is not visible while the cursor is moving.

Therefore, Strauss fails to disclose, either expressly or inherently, the claimed:

allowing a user to move a tracking symbol on a display; and  
moving a tracking menu in correspondence to the symbol **when  
the symbol encounters an edge of the menu.**

Accordingly, Applicants respectfully submit that claim 32 patentably distinguishes over the cited reference.

In a similar fashion, the rejection of claim 50 is also traversed. Note that claim 1 of Strauss includes:

In a graphical user interface of a computer system, a method for **changing a current function of a cursor during a drag operation on an object**, including the steps of:

**displaying, after initiation of the drag operation, a toolbar** containing at least one selectable control button, at least one control button defining an associated cursor function, wherein the toolbar indicates options available upon release of the dragged object for each area of the graphic user interface underlying a current position of the cursor;

**monitoring, during the drag operation**, for selection by the cursor of at least one of such control buttons having an associated cursor function;

**changing, during the drag operation**, the current function of the cursor to the cursor function associated with at least one selected control button; and

**removing the displayed toolbar after completion of the drag operation.**

(see Strauss, claim 1)

The menu of claim 50 requires no drag operation to be displayed and allows the user quick, effortless and unfettered access to tools available through the menu. All functionality including displaying the menu, monitoring, changing, and removing, require the drag operation in Strauss. Extra mouse clicks related to the dragging are time-consuming and taught away from this Application. In other words, the Drag Toolbar, which the Examiner understands to be analogous to the menu in the present Application, is dependent upon a drag operation and does not even display unless a drag operation is commenced, while the menu of the present Application is NOT related to any such operation.

Therefore, Strauss fails to disclose, either expressly or inherently, the claimed:

a tracking symbol positioned corresponding to an input transducer movable by a user; and

a mobile tracking region having a region boundary enclosing the tracking symbol with the tracking symbol being movable within the boundary when not dragging with the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving, and the region having controls activatable when the tracking symbol corresponds to the controls.

Both independent claims 51 and 52 recite similar elements and therefore both claims 51 and 52 are not disclosed, either expressly or inherently by Strauss.

In particular, claim 52 recites:

**a menu having an edge enclosing the tracking symbol with the tracking symbol being movable within the edge with the menu moving in correspondence to the tracking symbol when the tracking symbol encounters the edge while moving**

Strauss does not teach or suggest such.

V. REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 6-15, numbered paragraph(s) 11-12, claims 1-4, 6-7, 10-11, 14-15, 20-23, 25-27, 44-49 were rejected under 35 U.S.C. §103(a) in view of Strauss. The rejection is traversed and reconsideration is requested.

The Examiner, as noted on pages 7, 8 and 27 of the Action, bases the rejection on boiler plate language in Strauss "that various modifications may be made without departing from the spirit and scope of the invention." However, no modifications are suggested by Strauss that would accomplish the invention as admitted by the Examiner ("However, Strauss does not expressly teach that the region boundary is coincident with the menu boundary.") The Examiner's rationale is contradicted by the Examiner's own admission (Strauss says modifications can be made but provides no specifics as to what modifications can be made much less as to the modifications needed to reach these claims).

The Examiner's basis for the motivation to modify Strauss to make rejection is "The motivation is provide a user with a visual cue as to what the tracking boundary is so that the user may use the tracking menu more efficiently." (see Action pages 8 and 27) assumes that the "'follow-me' zone 42" as depicted in figure 7 and discussed at col. 7, lines 63-67 is invisible. It is suspected that the Examiner makes this assumption because a dashed line is used to show the zone 42 in figure 7. However, a dashed line is a visible thing in Strauss. Figure 1B shows the frame 5 with a dashed line and Strauss states:

FIG. 1B shows that selecting the graphic image 2 results in a visual change in the appearance of the graphic image 2 to indicate that it has been selected, and drawing of a frame 5 around the graphic image 2 to indicate the bounds of the graphic image 2.

(See Strauss, col. 3, lines 46-51)

In addition, a move control button 9 within the drag toolbar 7 of figure 1B also shows a dashed line, corner folded page. The dashed line is clearly intended to be visible as it depicts, in relation to the a solid line corner folded, page a drag operation indicated by an arrow. Further, the dashed line 3 of figure 1 is described as "the indicated drop spot". To describe the dashed line object as an indicated object appears mean that it is also a visible object. so, apparently the follow me zone dashed line 42 is intended to be a visible dashed line. As a result, in Straus the user does have a visible cue as to the tracking boundary. Thus, the Examiner's basis for the motivation is without a foundation.

At the very least, Strauss is ambiguous about whether the follow-me zone dashed line is visible or not. Motivation for a modification of a reference cannot be based on an ambiguous reference at the feature critical to the alleged motivation. For this reason, the rejection should be withdrawn.

Additionally, with the follow-me zone 42 of Straus being visible and located far from the menu 40, this teaches away from having a boundary coincident with the menu boundary.

The separation in space and time between the menu boundary and the follow-me zone 42 of Straus is intentional. Strauss col. 1, line 44-col. 2, line 15, describes the problem being solved as 1. inadvertent selections because several functions can be initiated by a drag operation, and 2. the user changing his mind. The separation between the boundary of the menu and the follow-me zone 42 solves the problems. The purpose of having the menu boundary and the separate follow me zone boundary 42 is to prevent inadvertent selections and allow the user the dragging space between the two boundaries as a region in which to decide what to do with the dragged object, such as move or copy, rather than simply use the default dragging function or have to memorize differing options as provided by specific and confusing default dragging options as provided by Microsoft Windows, Microsoft Word or Adobe Framemaker which differ by program and which are not "particularly intuitive." The solution is the separation. Thus, Straus teaches away from the claims for this reason.

On pages 26-28, in "Response to Arguments", particularly page 27, the Examiner interprets the follow me zone 42 as the edge of the menu. As noted above, this is contrary to the problem being addressed by Strauss. Further, if Strauss intended this then why is the menu (the drag tool bar as noted by the Examiner) provided with a separate reference number. If they

were intended to be the same, then why use different reference numbers. In making this interpretation the Examiner appears to be completely ignoring the author who labeled them separately. Additionally, this is contradictory to the explicit teachings of Straus. With respect to the relationship between the menu (drag tool bar) and the follow-me zone, Straus states:

In yet another embodiment of the invention, shown in FIG. 7, a Drag Toolbar 40 is initially displayed in reasonably close proximity to the cursor 4 but has a "follow me" zone 42 which **defines** the bounds of a region **around** the Drag Toolbar 40. If the cursor 4 is within the bounds of the "follow me" zone 42, the Drag Toolbar 40 does not move. However, if the cursor 4 attempts to move past the "follow me" zone boundary 42, the Drag Toolbar 40 follows the cursor across the user's display.

(See Strauss, col. 6, lines 59-67, emphasis added)

If Strauss had intended to make the boundary of the drag tool bar and the follow me zone 42 coincident, it would have been a mere matter of not including three words: "a region around". By eliminating or ignoring this definitional requirement of Straus, the Examiner is rewriting Strauss. Strauss explicitly teaches away from the idea of a menu boundary and a follow-me boundary being coincident.

Further, Strauss is directed to a way of simplifying drag operations by displaying a menu **only after an object is dragged** that provides a user with program specific options related to the dragged object, such as moving or copying the object. Those involved in the graphical related industries are required to make many trips and switches between toolbars during graphical design which can be difficult and time consuming. The present Application discloses an easily accessible, always available tracking menu that is unrelated to dragging an object, such as a drawing tool, which constantly tracks a cursor for use on a tablet PC, PDA, touch screen, etc. Such devices may have a small screen, limited space to display multiple toolbars, or even lack a keyboard and as a result lack the ability to utilize keyboard shortcut quick tool switches. In addition, on PC workstations that may extend over multiple displays, multiple tools essential for use of advanced graphical programs may be spread out on multiple displays and require time consuming mouse trips to traverse and change between tools. This Application eliminates time consuming mouse trips and mouse clicks. This is not addressed by Strauss.

In a non-limiting example, claim 1 of the present Application teaches a tracking symbol positioned according to an input transducer, such as a stylus for a tablet PC, which is movable by a user, and a menu having a menu boundary and comprising a mobile tracking region having

a **region boundary coincident with the menu boundary** and enclosing the tracking symbol with the tracking symbol being movable within the boundary with the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving, and the region having controls activatable when the tracking symbol corresponds to the controls.

In col. 3, lines 54-59, Strauss discusses and discloses that the Drag Toolbar is displayed at the commencement of the drag operation, when the cursor passes over a static icon, or if the cursor stops moving. In other words, the cited art requires dragging, passing over a static icon, or ceasing movement of the cursor for the Drag Toolbar to display. There are major differences between the prior art and the claims at issue because Strauss does not solve the problem addressed in the current Application such as the inability and difficulty of using menu driven software such as graphical programs on cramped workspaces on tablet PCs or PDAs and extremely large multi-display workstations.

Col. 8, lines 11-17 refer to the principal advantages of Strauss:

[Strauss] provides an unambiguous way for a user to change the functionality of a cursor **during a drag operation**. Thus, a user need not memorize different keyboard combinations, as in the prior art. Further, the graphical user interface is not cluttered, since a **Drag Toolbar only appears when a drag operation is initiated**.

In other words, the Drag Toolbar is dependent upon a drag operation, unlike the user interface claimed in claim 1 which is readily available for the user.

Furthermore, the Office Action admits that Strauss does not expressly teach that the region boundary is coincident with the menu boundary, but alleges that:

...it would be obvious to one of ordinary skill in the art at the time the invention was made to have implemented this limitation because Strauss suggests to the skilled artisan that a circular drag toolbar can be implemented using the disclose invention...The motivation is to provide a user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently.

The purpose of having the two boundaries in Strauss is to allow the user the dragging space between the two boundaries as a region in which to decide what to do with the dragged object, such as move or copy, rather than simply use the default dragging function or have to memorize

differing options as provided by specific and confusing default dragging options as provided by Microsoft Windows, Microsoft Word or Adobe Framemaker which differ by program and which are not "particularly intuitive."

Although the zone boundary has the same shape as the circular menu in Fig. 3A, this does not designate that Strauss inherently teaches that the two boundaries can be modified to be made coincident. As depicted in Fig. 7, both boundaries are clearly not coincident. In addition, the background discussion, col. 1, lines 44-46 teaches away from accidental selection of an object intended to only be dragged. By making both boundaries coincident, this does not solve this problem addressed in Strauss. In other words, one skilled in the art would not be motivated to modify Strauss in such a way as described to in the Office Action because making both boundaries coincident is contrary to the express teachings found in Strauss.

The Office Action's reasoning that allegedly renders the present Application obvious is a mere conclusory statement that is not grounded upon a rational underpinning because it is against the teaching of Strauss and there is no suggestion that this is known outside of the Applicant's disclosure. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

In addition to being related to a drag operation and lacking a teaching regarding the boundaries, col. 6, lines 59-67 do not expressly or inherently teach that the boundaries can be made coincident and nothing is taught about how the Drag Toolbar specifically functions once outside of the "follow me" zone. Col. 3, lines 54-59 provide the only disclosure about how the Drag Toolbar functions while moving (but not necessarily outside the "follow me" zone) which discloses that the toolbar would NOT be displayed while moving and would not display until the toolbar "stops moving for awhile." Nothing further is provided. In other words, it would not have been obvious to make both the region boundary coincident with the menu boundary because there is nothing to suggest this either expressly or inherently in Strauss. In addition, little to no disclosure is provided about functionality of the toolbar while moving in Strauss, the only cited reference.

Thus, the contention in the Office Action at page 8 that Strauss suggests that a skilled artisan would modify Strauss such that the region boundary is coincident with the menu

boundary fails because according to MPEP 2144.03, the Office Action does not have a basis for such reasoning set forth explicitly. In addition, "[t]he examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241; MPEP 2144.03.

According to MPEP 2144.03,

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not **capable of instant and unquestionable demonstration as being well-known**.

Nothing in *Strauss* provides one with a capability of instant and unquestionable demonstration that it would be obvious to make the two boundaries coincident. In addition, there are no specific factual findings predicated on sound technical and scientific reasoning provided in the Office Action. The Office Action alleges that there is a motivation to provide the user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently, but this is not predicated on sound technical and scientific reasoning, but rather is against express and inherent teachings and is impermissible hindsight. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553; 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher").

The Examiner is reminded that according to MPEP 2142,

Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In short, *Strauss*, disclosed by the Applicant, does not provide one skilled in the art with an obvious motivation based on sound technical and scientific reasoning like that found in paras.

[0042] and [0049] of the present Application to modify the two boundaries such that they are coincident. As found in nearly every Application, the present Application in para. [0065] contains disclosure like that of col. 8 lines 63-67 of Strauss and this provides no more of an motivation. "The fact that the invention seems simple after it is made does not determine the question; if this were the rule many of the most beneficial patents would be stricken down." *Expanded Metal Co. v. Bradford*, 214 U.S. 366, 381 (1909).

Because the disclosure and discussion of Strauss is only related to a toolbar **accessible after a dragging operation by the user** and the problem addressed in Strauss would not be solved by modifying the region boundary and the menu boundary to be coincident as suggested by the Office Action, Applicants respectfully submit that a *prima facie* case of obviousness can not be based upon Strauss, because Strauss fails to disclose and suggest the claimed:

a tracking symbol positioned corresponding to an input transducer movable by a user; and

a menu having a menu boundary and comprising a mobile tracking region having **a region boundary coincident with the menu boundary** and enclosing the tracking symbol with the tracking symbol being movable within the boundary with **the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving**, and the region having controls activatable when the tracking symbol corresponds to the controls.

Accordingly, Applicants respectfully submit that claim 1 patentably distinguishes over the cited references.

Further, as discussed above, Strauss is directed dragging. As a result, the follow-me discussed at col. 6, lines 59-67 is active only when the dragging operation is itself active (see Abstract). In contrast, the moving of claim 1 is "when the tracking symbol encounters the boundary while moving" (claim 1). For this additional reason, the rejection should be withdrawn.

Claim 25 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed:

a first tracking symbol having a first tracking symbol position controllable by the user; and

a second tracking symbol containing the first tracking symbol, having a second tracking symbol position controlled by the first tracking symbol and having objects selectable by the first tracking symbol the second tracking symbol having a menu containing the selectable objects with the menu having a menu boundary and comprising **a mobile tracking region having a region boundary coincident with the menu boundary.**

Therefore, Applicants respectfully submit that claim 25 patentably distinguishes over the cited reference.

Claim 46 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed apparatus, including:

a position transducer;

a display; and

a computer coupled to the display and the transducer, and producing for display a first tracking symbol having a first tracking symbol position controllable by the transducer and a second tracking symbol containing the first tracking symbol, having a second tracking symbol position controlled by the position of the first tracking symbol and having controls selectable by the first tracking symbol the second tracking symbol having a menu containing selectable objects with **the menu having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary.**

Therefore, Applicants respectfully submit that claim 46 patentably distinguishes over the cited reference.

Claim 48 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed:

computer readable storage controlling a computer with a first tracking symbol having a first tracking symbol position controllable by the user; and a second tracking symbol containing the first tracking symbol, having a second tracking symbol position controlled by the first tracking symbol and having a menu with objects selectable by the first tracking symbol **with the menu having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary.**

Therefore, Applicants respectfully submit that claim 48 patentably distinguishes over the cited reference.

Claim 28 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed interface including:

- a display;

- a tracking menu positioned above the display, having an edge and having controls positioned in the menu with **the menu having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary;**

- a tracking symbol positioned above the menu, **encountering the edge of the boundary when moved and moving the menu when the edge is encountered.**

Therefore, Applicants respectfully submit that claim 28 patentably distinguishes over the cited reference.

Claim 47 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed:

- computer readable storage controlling a computer by allowing a user to move a tracking symbol on a computer display; and moving a tracking menu in correspondence to the symbol **when the symbol encounters an edge of the menu the menu containing selectable objects with the menu having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary.**

Therefore, Applicants respectfully submit that claim 47 patentably distinguishes over the cited reference.

Claim 44 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed:

moving a first tracking symbol responsive to movement of a second tracking symbol the first tracking symbol having a menu containing selectable objects with **the menu having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary** and moving the second tracking symbol responsive to an input transducer.

Therefore, Applicants respectfully submit that claim 44 patentably distinguishes over the cited reference.

Claim 45 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed:

using a single cursor movement to both move and activate a mobile control the mobile control having a menu containing selectable objects with the menu having a menu boundary and comprising **a mobile tracking region having a region boundary coincident with the menu boundary.**

Therefore, Applicants respectfully submit that claim 45 patentably distinguishes over the cited reference.

Claim 49 was rejected upon the same grounds as claim 1, therefore, this rejection is respectfully traversed because a *prima facie* case of obviousness can not be based upon Strauss because Strauss fails to disclose and suggest the claimed:

a display area that tracks a cursor tool when the cursor tool reaches a boundary of the area and that has a display function;  
and

the cursor tool movable within the area and that drags the area around when the boundary is reached and being activated by an input event the area having a menu containing selectable objects with the menu having a menu boundary and comprising **a mobile tracking region having a region boundary coincident with the menu boundary.**

Therefore, Applicants respectfully submit that claim 49 patentably distinguishes over the cited reference.

Dependent claims 2-4, 6-7, 10-11, 14-15, 20-23, and 26-27 recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence upon claims 1 and 25.

The dependent claims are also independently patentable.

For example, claim 2, dependent on claim 1, calls for the menu to have a visible edge when the cursor is moving and when the cursor encounters the edge and the menu is moved by tracking the cursor. In contrast, the Drag Toolbar of Strauss only appears when the drag operation is initiated (see Abstract)

For example, claim 15 recites that the "symbol is allowed to cross the boundary". The Examiner points to Strauss at col. 6, lines 59-67 for this. The text of Straus states:

In yet another embodiment of the invention, shown in FIG. 7, a Drag Toolbar 40 is initially displayed in reasonably close proximity to the cursor 4 but has a "follow me" zone 42 which defines the bounds of a region around the Drag Toolbar 40. If the cursor 4 is within the bounds of the "follow me" zone 42, the Drag Toolbar 40 does not move. However, if the cursor 4 attempts to move past the "follow me" zone boundary 42, the Drag Toolbar 40 follows the cursor across the user's display.

(See Strauss, col. 6, lines 59-67)

This text says nothing about allowing crossing of the tracking boundary.

As another example, claim 21 calls for the tracking boundary to be a jutting wall. The Examiner points to 42 of figure 7. 42 is a circle and not a jutting wall.

In the Office Action, at pages 15-18, numbered paragraph(s) 13, claims 8-9, 13, 24, 34-38 were rejected under 35 U.S.C. §103(a) over Strauss in view of Iwema et al. Patent No. US 7,058,902 B2. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Dependent claims 8-9, 13 and 24 recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence upon claim 1.

The dependent are independently patentable. For example, claim 13 calls for a predetermined stop condition to be an out-of-range condition. the Examiner points to Iwema and states ""stylus 204 can [be] cause the menu to reposition or display by hovering over the tablet without touching the screen." If the stylus is being sensed as the Examiner states it is an in-range condition, not an out of range condition.

As another example, claim 35 calls for making the menu transparent when the stylus touches the tablet. The Examiner points to Strauss at col. 1, lines 18-20 for this. This text states:

Graphical user interfaces ("GUIs") typically use a pointing device (such as a mouse, light pen, or stylus on a touch-sensitive display screen) to select an object (e.g., text, figures, areas of a display screen, files, folders or directories, object tools, parts of figures or other objects such as vertices and edges, etc.) under a cursor and then "drag" the selected object to a different location or orientation on a display screen. The user may then "drop" or release the object at a desired new location or orientation indicated by the position of the cursor.  
(See Strauss, col. 1, lines 18-27)

This text says nothing about making the menu transparent.

In the Office Action, at pages 18-19, numbered paragraph 14, claims 16 and 40 were rejected under 35 U.S.C. §103(a) over Strauss in view of Hoeber et al. Patent No. US 5,276,795. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Dependent claims 16 and 40 recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence from independent claims.

These dependent claims are separately patentably distinct. For example, claim 40 calls for "allowing the user to designate a position for the menu **and** allowing the tracking symbol to cross the edge without moving the menu". The Examiner has pointed to no place in the prior art where this is taught.

In the Office Action, at pages 19-21, numbered paragraph 15, claims 5, 12, 19, 29-30 and 43 were rejected under 35 U.S.C. §103(a) over Strauss in view of Nicholas Patent No. US 6,865,719 B1. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Dependent claims 5, 12, 19, and 29-30 recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence from independent claims.

These claims are also patentably distinct. For example, claim 5 calls for transparency. The Examiner is referred to the discussion of claim 35 above.

As another example, claim 12 calls for Euclidean distance repositioning. The Examiner points to figure 4A of Nicholas. There is not discussion of such distances anywhere in Nicholas.

In the Office Action, at pages 21-22, numbered paragraph 16, claim 39 was rejected under 35 U.S.C. §103(a) over Strauss in view of Microsoft Excel 2000 (screen captures from Microsoft Excel 2000). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Dependent claim 39 recites patentably distinguishing features of its own or is at least patentably distinguishing due to its dependence upon an independent claim 32.

In the Office Action, at pages 22-23, numbered paragraph 17, claims 17-18 and 41-42 were rejected under 35 U.S.C. §103(a) over Strauss in view of Hoeber and further in view of Nicholas. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Dependent claims 17-18 and 41-42 recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence upon independent claims 1 and 32.

In the Office Action, at pages 23-26, numbered paragraph 18, claim 31 was rejected under 35 U.S.C. §103(a) over Strauss in view of Iwema and further in view of Nicholas. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

In a non-limiting example, claim 31 comprises a graphical user interface whereby a tracking symbol positioned according to a stylus input transducer movable by a user and a mobile tracking menu region has a region boundary enclosing the tracking symbol

The Office Action, at page 26, alleges that:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the function of trailing message as taught by Nicholas to the tracking menu as taught by Strauss and as modified by Iwema to improve the message display and thus enable a user to conveniently receive and access data and related applications, and collaborates with other uses, without interfering with the operation of running applications or services.

As illustrated above, Strauss does not expressly or inherently teach that the region boundary is coincident with the menu edge, but rather teaches away. Furthermore, Nicholas does not refer to persistent objects such as a taskbar as disclosed in the present Specification in para. [0053], but a method for displaying a message on areas designated for web pages. Accordingly, Applicants respectfully submit that a *prima facie* face of obviousness can not be based upon Strauss, Iwema, and Nicholas, because Strauss, Iwema, and Nicholas, and any combination thereof fail to disclose and suggest the claimed:

- a tracking symbol positioned corresponding to a stylus input transducer movable by a user; and

- a mobile tracking menu region having a region boundary enclosing the tracking symbol with the tracking symbol being movable within the boundary with the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving, the menu region having visible menu edge coincident with the boundary, the menu region having button controls activatable when the tracking symbol corresponds to the controls with a control changed in appearance when the tracking symbol is over the control and is active, the menu region being semi-transparent when the tracking symbol is inactive and transparent when the tracking symbol is active, where the tracking symbol can be activated by the user selecting one of the controls and performs a selected function when active,

- wherein the tracking symbol and region are displayed on a tablet display, and the tracking symbol is activated when the stylus touches the tablet,

- wherein the positioning corresponding to the motion of the input transducer stops when the stylus is out of range of the tablet and the menu region is repositioned a least Euclidean distance from the prior position corresponding to the tracking symbol when the condition no longer exists,

- wherein the interface comprises an outline of the mobile tracking region when the tracking symbol is over a persistent object and the interface is clipped as the tracking symbol exits the persistent object, and

- wherein the mobile tracking region deforms corresponding to a shape of a persistent object when the symbol comes in a vicinity of a persistent object or display edge.

Accordingly, Applicants respectfully submit that claim 31 patentably distinguishes over the cited references.

VI. CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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